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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,944	09/20/2001	Thierry Sert	05221.00003	3072
22907	7590	12/01/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			BEKERMAN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/936,944	SERT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 August 2006.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14, 16-23, 25 and 26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 14, 16-23, 25, and 26 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This action is responsive to papers filed 8/28/2006.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 14, 16, 17, 21-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,889,198) in view of Kelly (U.S. Patent No. 6,293,865).**

**Regarding claims 14, 16, 22, 23, and 25,** Kawan teaches a means for reading coded data from the memory of a smart card (Figure 1, Reference 16), storage means (Figure 1, Reference 6, and Column 5, Lines 1-3), calculating means (updating and formatting for display, the displaying of any information on the card is taken to read on uniform display) (Column 5, Lines 35-38), data-display means (Figure 1, Reference 10), data registers (Column 6, Lines 6-10), several different merchants (Column 2, Lines 18-20), several loyalty programs (Column 6, Lines 15-18), and means for navigation (Column 5, Lines 7-9). Kawan teaches displaying of different products and the respective amounts of loyalty points required to obtain each product (Column 7, Lines

45-48). Kawan doesn't teach displaying that information in the format of a graded scale. Kelly teaches a gaming system that totals performance and gives a reward based on that performance. Figure 13, Reference 1308 shows a graduated scale of number of points earned through the game, and the number of prize bucks that those points are exchangeable for. Reference 1306 of that same figure shows the total amount of prize bucks earned up to that point. Examiner considers the entirety of Figure 13 to be a graduated scale, and thus the amount of prize bucks in Reference 1306 is considered to be part of the graduated scale. Since the prize bucks are inherently updated dynamically, the graduated scale is updated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to display prizes available along with the amount of points needed to obtain an item and to display a marker indicating current performance. This would give the consumer a better impression of how many award points they have and what prizes those points could be redeemed for. The calculations of claim 16 are seen as inherent calculations in obtaining current scale level and interval distance.

**Regarding claim 17,** Kawan teaches the navigation means as being a touch screen (Column 5, Lines 10-11).

**Regarding claims 21 and 26,** Kawan teaches comparing data input with data stored and displaying the results of this comparison in order to keep information updated (Column 6, Lines 56-66).

2. **Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,889,198) in view of Kelly (U.S. Patent No. 6,293,865), and further in view of Fox (U.S. Patent No. 5,943,624).**

**Regarding claims 18-20,** Kawan teaches a smart card interacting with a kiosk to display loyalty points. Kawan doesn't teach a portable phone, satellite decoder, or PDA. Fox teaches a cell phone that communicates, displays, and updates information from a smart card (this cell phone is taken to inherently include GPS technology, which reads on the satellite decoder) (Column 2, Lines 21-29). Official notice is taken that wireless PDA telecommunication technology is old and well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to not only display the contents of the smart card loyalty registers on the terminal of Kawan, but to allow display of the smart card on other devices as well for greater comfort and flexibility.

#### ***Response to Arguments***

3. In response to the issue of displaying data in a uniform way, applicant argues "merely displaying a point balance is different than displaying data for 'a plurality of merchant loyalty programs' formatted and displayed in a uniform way". Examiner sets forth that the limitation "displayed in a uniform way" may be interpreted very broadly. Figure 8 of Kawan shows the operation of a stand alone terminal. Since Kawan has already taught multiple merchants, this process inherently does not differ between merchants. References S33 and S34 each teach the display of loyalty point balance

and redeemable merchandise. Since this information is displayed for all merchants, this is considered to be a uniform display. Further, “displayed in a uniform way” may also be interpreted as follows. Should a user cease interaction with a terminal using the smart card, and then immediately initiate a new interaction, the information layout would inherently be displayed in same format as the previous interaction. This would also read on “uniform”.

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. In response to the issue of updating data dynamically, Examiner considers the entirety of Kelly Figure 13 to be a graduated scale. Thus, the graduated scale is updated dynamically with Reference 1306.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON  
PRIMARY EXAMINER